

### **REMARKS**

Applicants respectfully request reconsideration of the present application. No new matter has been added to the present application. Claims 1-14 have been rejected in the Office Action. Applicants have amended claim 1 and have presented claims 2-14 in their original or previously presented form. Applicants have added dependent claims 15-20. Accordingly, claims 1-20 are pending herein. Claims 1-20 are believed to be in condition for allowance and such favorable action is respectfully requested.

### **Entry of Amendment After Final Rejection**

Applicants respectfully assert that the amendments presented herein require only a cursory review by the Examiner, and respectfully request that the Examiner enter such amendments.

### **Amendments to the Claims**

Claim 1 has been amended to correct a typographical error and dependent claims 15-20 have been added. Care has been exercised to avoid the introduction of new matter.

Support for claims 15 and 18 may be found in the Specification, for example, at page 6, line 2-3 and at page 11, lines 9-11. Support for claims 16, 17, 19, and 20 may be found in the Specification, for example, at page 10, line 13 through page 11, line 6.

### **Rejections of the Claims**

#### **A. Rejections based on Richard and Krause**

Claims 1, 2, 7, and 8 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,781,611 (Richard) in view of U.S. Patent No. 6,160,554 (Krause). As a *prima facie* case of obviousness has not been established and the references were improperly combined, Applicants respectfully traverse this rejection, as hereinafter set forth.

1. *Lack of Suggestion or Motivation to Combine the Cited References*

MPEP §§ 706.02(j), 2142, and 2143 each set forth the contents of an obviousness rejection under § 103: "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)". See MPEP §§ 706.02(j), 2142, and 2143.

Factual findings in support of a *prima facie* case of obviousness must be supported by substantial evidence. *In re Zurko*, 59 USPQ2d 1693, 1696 (Fed. Cir. 2001).

"The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. 'To support the conclusions that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.' *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat App. & Inter. 1985)." MPEP § 2142. MPEP § 2142 further states that "[w]hen the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the examiner to explain why the combination of the teachings is proper." The Examiner is required to present actual evidence and make particular findings related to the motivation to combine the teachings of the references. *In re Kotzab*, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000); *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). "Broad conclusory statements regarding the teaching of multiple references, standing alone, are not "evidence." *Dembiczak*, 50 USPQ2d at 1617. "'The factual inquiry whether to combine the references must be thorough and searching.'" *In re Lee*, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002) (citing *McGinley v. Franklin Sports, Inc.*, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001)). The factual inquiry must be based on objective evidence of record, and cannot be based on subjective belief and unknown authority. *Id.*

at 1433-34. The Examiner must explain the reasons that one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious. *In re Rouffet*, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998).

The Office Action has not presented any evidence why Richard and Krause would have been combined. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. MPEP § 2143.01. Specifically, there must be a suggestion or motivation in the references to make the combination or modification. *Id.* The sole support in the Office Action for such a combination is that “[i]t would have been obvious to an artisan at the time of the invention to include Krause’s teaching with method of Richard in order to provide an improved representation of a file.” Office Action, pg. 3. The Office Action cannot rely on the benefit of the combination without first supporting the motivation to make the combination. Such motivation does not appear anywhere in either of the references, and the Office Action has not presented any actual evidence in support of the same. Instead, the Office Action relies on broad conclusory statements, subjective belief, and unknown authority. Such a basis does not adequately support the combination of references; therefore, the combination is improper and should be withdrawn.

## 2. *The Cited References Are Improperly Combined*

Applicants also respectfully submit that Richard and Krause were improperly combined because Krause teaches away from a combination with Richard. “[I]t is improper to combine references where the references teach away from their combination.” MPEP § 2145. Richard discusses a plurality of application windows must be open and running. However, Krause disparages this element as disadvantageous in at least three locations: (1) “Another option available to the computer operator is to launch an application capable of interpreting the format of the file he wishes to use or view. This solution consumes both time and resources. The operator has to wait for the application to load and run before he can view the file.” Krause, at col. 1, lines 33-37. (2) “In a preferred embodiment, the invention provides the ability to view an abbreviated description of a file’s content or intended use without the operator having to explicitly open it using an application designed to interpret the file’s contents, or to execute it.” Krause, at col. 1, lines 52-56. (3) “Using

the teachings of the present patent document, the operator does not have to... read the contents of the file by launching an application program for that purpose.” Krause, at col. 1, line 66 to col. 2, line 3.

Thus, Krause does not contemplate a plurality of open applications, and in fact, teaches away from such an environment and thus teaches away from Richard. Accordingly, the combination of Richard and Krause is improper and should be withdrawn.

### *3. References Fail to Teach or Suggest All Claim Limitations*

The Office Action indicates that Richard fails to teach displaying an extracted graphical preview of the content of an open application window and relies upon Krause for this limitation. Office Action, at pg. 3. Applicants respectfully submit that Krause fails to teach or suggest “displaying an extracted graphical preview of the content for one of the plurality of open application windows” as required by claims 1, 2, 7, and 8. Krause is directed to determining the content of a closed file without having to open the file. By placing a mouse cursor over a file icon or by performing a series of mouse clicks, a window may be generated that provides preview information for the unopened file. The present invention is concerned with the problem of switching between multiple open application windows, not with determining the content of a single, unopened file. Krause lacks any teaching or suggestion of displaying an extracted preview of the content for an open application window as necessitated by claims 1, 2, 7, and 8. Accordingly, Applicants respectfully submit that the references fail to teach or suggest all of the limitations of claims 1, 2, 7, and 8, and, thus, a prima facie case of obviousness has not been established.

For the reasons stated above, Applicants respectfully submit that claims 1, 2, 7, and 8 are non-obvious over Richard in view of Krause. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 1, 2, 7, and 8 under 35 U.S.C. § 103(a). Claims 1, 2, 7, and 8 are believed to be in condition for allowance and such favorable action is respectfully requested.

### *B. Rejections based on Richard, Krause, and Staab*

Claims 3 and 4 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,781,611 (Richard) in view of U.S. Patent No. 6,160,554 (Krause) further in view of U.S. Patent No. 5,499,334 (Staab). The rejections of claim 3 and 4 each rely in part on the

combination of Richard and Krause similar to the rejections for claims 1, 2, 7, and 8. Accordingly, these claims are believed to be in condition for allowance for at least the above-cited reasons.

The Office Action also indicates that the combination of Richard and Krause fails to teach upon receipt of the switching input, displaying a preview for each of the plurality of open application windows. Office Action, at pg. 4. The Office Action relies upon the combination of Staab to teach this limitation. *Id.* However, Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness for claims 3 and 4 regarding the combination of Staab with Richard and Krause as hereinafter set forth.

*1. Lack of Suggestion or Motivation to Combine the Cited References*

There is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the reference teachings. The Office Action has not presented any evidence why Staab would have been combined with Richard and Krause. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. MPEP § 2143.01. Specifically, there must be a suggestion or motivation in the references to make the combination or modification. *Id.* The sole support in the Office Action for such a combination is that “[i]t would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the method of Staab with the method of Richard and Krause in order to provide an improved representation of a desktop space.” Office Action, pg. 4. The Office Action cannot rely on the benefit of the combination without first supporting the motivation to make the combination. Such motivation does not appear anywhere in either of the references, and the Office Action has not presented any actual evidence in support of the same. Instead, the Office Action relies on broad conclusory statements, subjective belief, and unknown authority. Such a basis does not adequately support the combination of references; therefore, the combination is improper and should be withdrawn.

*2. References Fail to Teach or Suggest All Claim Limitations*

Moreover, Applicants respectfully submit that the Staab reference fails to teach or suggest “displaying an extracted preview of the content for each of the plurality of open applications

windows” as required by claims 3 and 4. Rather, Staab teaches a system and method for managing desktop configurations of inactive programs. A desktop or windows configuration is “the location and size (configuration) of each window on the display.” Staab, at col. 1, lines 44-47. The system discussed in Staab allows a user to save a window configuration, modify the configuration while the applications are inactive, and then activate the saved configuration. Staab, at col. 2, lines 14-28. When a window configuration is activated, the system “activates any currently-inactive programs that are associated with a saved window configuration.” Staab, at col. 2, lines 28-30. Thus, the system in Staab allows users to employ a saved desktop configuration to activate multiple applications with the window for each application configured on the desktop in the manner of the saved desktop configuration. However, the Staab reference lacks any teaching or suggestion of displaying a preview of each of a plurality of applications windows that are currently open. Accordingly, Applicants respectfully submit that the references fail to teach or suggest all of the limitations of claims 3 and 4, and, thus, a prima facie case of obviousness has not been established.

For the reasons stated above, Applicants respectfully submit that claims 3 and 4 are non-obvious over Richard in view of Krause and further in view of Staab. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 3 and 4 under 35 U.S.C. § 103(a). Claims 3 and 4 are believed to be in condition for allowance and such favorable action is respectfully requested.

C. Rejections based on Richard, Krause, and Kitami

Claims 5, 6, 9, 10, and 12-14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,781,611 (Richard) in view of U.S. Patent No. 6,160,554 (Krause) further in view of U.S. Patent No. 5,668,962 (Kitami). The rejections of claim 5, 6, 9, 10, and 12-14 each rely in part on the combination of Richard and Krause similar to the rejections for claims 1, 2, 7, and 8. Accordingly, these claims are believed to be in condition for allowance for at least the above-cited reasons.

The Office Action also indicates that the combination of Richard and Krause fails to teach the method wherein each of the plurality of open application windows is ranked according to an activation hierarchy, and wherein the displayed preview is the window immediately succeeding the

current open application window in the activation hierarchy. Office Action, at pg. 5. The Office Action relies upon the combination of Kitami to teach this limitation. *Id.* However, Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness for claims 5, 6, 9, 10, and 12-14 regarding the combination of Kitami with Richard and Krause as hereinafter set forth.

*1. Lack of Suggestion or Motivation to Combine the Cited References*

There is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the reference teachings. The Office Action has not presented any evidence why Kitami would have been combined with Richard and Krause. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. MPEP § 2143.01. Specifically, there must be a suggestion or motivation in the references to make the combination or modification. *Id.* The sole support in the Office Action for such a combination is that “[i]t would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the method of Kitami with the method of Richard and Krause in order to provide a simplified method of selecting a desired window.” Office Action, pg. 5. The Office Action cannot rely on the benefit of the combination without first supporting the motivation to make the combination. Such motivation does not appear anywhere in either of the references, and the Office Action has not presented any actual evidence in support of the same. Instead, the Office Action relies on broad conclusory statements, subjective belief, and unknown authority. Such a basis does not adequately support the combination of references; therefore, the combination is improper and should be withdrawn.

*2. References Fail to Teach or Suggest All Claim Limitations*

Moreover, Applicants respectfully submit that the Kitami reference fails to teach or suggest that each of the plurality of open application windows is ranked according to an activation hierarchy as required by claims 5, 6, 9, 10, and 12-14. Rather, Kitami discusses a system for managing a number of windows using a window identifier list. *See* Kitami, at Abstract. The window identifier list includes window identifiers that are designated by a user. *Id.* Thus, the identifier list is only “a

limited subset of all opened windows currently operating on the window system.” *Id.* The Kitami reference lacks any teaching or suggestion of ranking each of the plurality of open application windows according to an activation hierarchy. Accordingly, Applicants respectfully submit that the references fail to teach or suggest all of the limitations of claims 5, 6, 9, 10, and 12-14, and, thus, a prima facie case of obviousness has not been established.

For the reasons stated above, Applicants respectfully submit that claims 5, 6, 9, 10, and 12-14 are non-obvious over Richard in view of Krause and further in view of Kitami. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 5, 6, 9, 10, and 12-14 under 35 U.S.C. § 103(a). Claims 5, 6, 9, 10, and 12-14 are believed to be in condition for allowance and such favorable action is respectfully requested.

D. Rejections based on Richard, Krause, Kitami, and Staab

Claim 11 was rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,781,611 (Richard) in view of U.S. Patent No. 6,160,554 (Krause) in view of U.S. Patent No. 5,668,962 (Kitami) further in view of U.S. Patent No. 5,499,334 (Staab).

The rejection of claim 11 relies in part on the combination of Richard and Krause similar to the rejections for claims 1, 2, 7, and 8. Accordingly, these claims are believed to be in condition for allowance for at least the above-cited reasons. In addition, the rejection of claim 11 relies in part on the combination of Kitami with Richard and Krause similar to the rejections for claims 5, 6, 9, 10, and 12-14. Accordingly, these claims are believed to be in condition for allowance for at least the above-cited reasons. Further, the rejection of claim 11 relies in part on the combination of Staab similar to the rejections for claims 3 and 4. Accordingly, these claims are believed to be in condition for allowance for at least the above-cited reasons.

For the reasons stated above, Applicants respectfully submit that claim 11 is non-obvious over Richard in view of Krause in view of Kitami and further in view of Staab. Accordingly, Applicants respectfully request withdrawal of the rejection of claim 11 under 35 U.S.C. § 103(a). Claim 11 is believed to be in condition for allowance and such favorable action is respectfully requested.



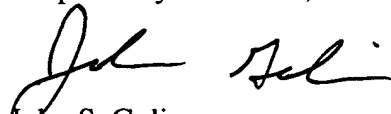
### **New Claims**

New dependent claims 15-20 have been added in the listing of claims. Claims 15 and 18 are directed to the method of claim 1 with the additional limitation of "upon receipt of the switching input, displaying description information for each of the plurality of open application windows." Claim 16 is directed to the method of claim 1 wherein the switching input is independent of any open application. Likewise, claim 19 is directed to method of claim 9 wherein the switching activation signal is independent of any open application. Claim 17 is directed to the method of claim 1 wherein the switching input comprises a keyboard input. Likewise, claim 20 is directed to the method of claim 9 wherein the switching activation signal comprises a keyboard input. Applicants respectfully submit that the cited references, either alone or in combination, fail to teach or suggest the limitations of each of claims 15-20. Accordingly, claims 15-20 are believed to be in condition for allowance and such favorable action is respectfully requested.

### **Conclusion**

For the reasons stated above, claims 1-20 are believed to be in condition for allowance. Applicants respectfully request withdrawal of the pending rejections and allowance of claims 1-20. If any issues remain that would prevent issuance of this application, the Examiner is urged to contact the undersigned by telephone prior to issuing a subsequent action. It is believed that no fee is due in conjunction with the present amendment. However, if this belief is in error, the Commissioner is hereby authorized to charge any amount required to Deposit Account No. 19-2112.

Respectfully submitted,



John S. Golian  
Reg. No. 54,702

JSG/tjd  
SHOOK, HARDY & BACON L.L.P.  
2555 Grand Blvd.  
Kansas City, MO 64108-2613  
816-474-6550